

REMARKS/ARGUMENTS

Status of Claims

Claims 1-17 and 19 are pending in this application with claims 1, 8, and 16 being the only independent claims. Claims 2, 4-7, 9, and 11-15 have been withdrawn from consideration in view of the Species Election Requirement. Claims 18 and 20 have been cancelled without prejudice or disclaimer. Claims 1, 8, and 16 have been amended to address the minor informalities raised in the Office Action without narrowing the scope of any claim element.

No new matter has been added.

Overview of the Office Action

Claims 1, 3, and 16-20 stand objected to due to minor informalities, which have been addressed in the above claim amendments.

Claims 1, 3, 8, 10, and 18-19 stand rejected under 35 U.S.C. §103(a) as unpatentable over Sakai (JP 11-320989A).

Claims 16-17 and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over Burkart (US 6,437,815) in view of Sakai.

Patentability of the Claimed Invention

A. Independent Claim 1

Independent claim 1 recites the following claim features:

the control unit is arranged to activate the medium transport device in such a way that the medium transport device carries out a rest state transport at periodic intervals, and at the start of an activation of the printer caused by receipt of a print job before processing the print job,

during the rest state transport, the medium transport device transports the printing medium in and opposite to the output transport direction.

Accordingly, independent claim 1 requires that the rest state transport is performed both (1) at periodic intervals, and (2) in response to receipt of a print job.

Even if Sakai is considered to disclose conveying a recording form periodically in a rest or waiting state, which Applicant's do not necessarily admit, Sakai fails to teach the additional step of performing the same movement of the recording form upon receipt of a print job. Thus, Sakai fails to disclose "the medium transport device carries out a rest state transport at periodic intervals, and at the start of an activation of the printer caused by receipt of a print job before processing the print job", as expressly recited in independent claim 1. Nevertheless, the Office Action states that it would be obvious to perform the rest state transport at the start of an activation of the printer caused by a print job to ensure the printing medium is not stuck (see pages 4-5 of the Office Action). Applicants respectfully traverse the above statement asserted in the Office Action, because Sakai fails to disclose teach or suggest the desirability of an additional movement of the recording form immediately before performing a print job. The Examiner's statement neither addresses the above-recited claim features recited in independent claim 1 nor is supported by any evidence, such as citation to the prior art or any of the rationales for supporting *prima facie* obviousness discussed in the Manual of Patent Examining Procedure (MPEP).

In the rejection of independent claim 1, the Examiner admits that at least carrying out a rest state transport "at the start of an activation of the printer caused by receipt of a print job before processing the print job" is not disclosed by the prior art. However, Examiner states that it would be obvious to add this feature.

In this case, the above statement by the Examiner is not supported by any evidence, such as citation to the prior art, or by any of the rationales for supporting *prima facie* obviousness specified in the MPEP. More specifically, the Office Action merely points out that Sakai

broadly teaches carrying out a rest state transport at periodic intervals and fails to articulate reasoning with some rational underpinning to support the conclusion of obviousness. Without any rational underpinning for the additional movement recited in the claims, the above conclusory statement asserted in the Office Action is an improper reliance on impermissible hindsight analysis. Therefore, the Office Action failed to establish a case of *prima facie* obviousness against independent claim 1.

In view of the above reasons, independent claim 1 patentably distinguishes and is allowable over Sakai. Withdrawal of the claim rejection of independent claim 1 is requested.

B. Independent Claim 8

Independent claim 8 recites the following:

transporting a printing medium with a medium transport device in and opposite to an output transport direction at periodic intervals, and at the start of an activation of the printer caused by receipt of a print job before processing the print job.

The Office Action acknowledges that Sakai fails to teach the above-recited claim features of independent claim 8 (see page 4 of the Office Action). Nevertheless, the Office Action states that it would be obvious to perform the rest state transport at any desired time between printing operation, including at the start of activation of a printer which is about to process a received print job, to insure the printing medium is not stuck (see page 6 of the Office Action).

For similar reasons stated in the above Section A, the Office Action is conclusory and failed to establish a case of *prima facie* obviousness against independent claim 8. Therefore, independent claim 8 patentably distinguishes and is allowable over Sakai. Withdrawal of the claim rejection of independent claim 8 is respectfully requested.

C. Independent Claim 16

Independent claim 16 recites the following:

the control unit is arranged to activate the medium transport device in such a way that, at the start of an activation of the printer caused by receipt of a print job by the control unit from the higher order controller and before processing the print job, the medium transport device carries out a rest state transport, within which rest state transport, the medium transport device transports the printing medium in and opposite to the output transport direction.

The Office Action acknowledges that Burkart fails to teach the above-recited claim features of independent claim 16 (see page 7 of the Office Action) but cites Sakai to remedy the deficiencies of Burkart.

Based on similar reasons stated in the above Section A, Sakai does not teach what Burkart lacks. Therefore, independent claim 16 patentably distinguishes and is allowable over the combination of Burkart and Sakai. Withdrawal of the claim rejection of independent claim 16 is respectfully requested.

D. Dependent Claims 3, 10, 17, and 19

Claims 3, 10, 17, and 19 depend, either directly or indirectly, from independent claim 1, 8, or 16 and are thus allowable therewith.

In addition, these claims include features which serve to even more clearly distinguish the present claimed invention over the prior art of record.

E. Dependent Claims 2, 4-7, 9, and 11-15

Applicants respectfully request that the Examiner consider the additional species covered by claims 2, 4-7, 9, and 11-15 and rejoin the same in the subject application upon the allowance of the generic or linking claims—-independent claims 1 and 8.

Conclusion

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

No fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our PTO Deposit Account No. 03-2412.

Respectfully submitted,
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